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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,224	08/27/2003	Masaki Sano	03151	4309

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DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA, VA 22314

EXAMINER

MONDT, JOHANNES P

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,224

Applicant(s)

SANO, MASAKI

Examiner

Johannes P. Mondt

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 7, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 7, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/06 has been entered.

Response to Amendment

After-Final Amendment filed 2/27/06 has been entered in light of aforementioned Request for Continued Examination. In said Amendment applicant substantially amended claims 3, 7-8 and 10 through substantial amendment of claim 7. Comments on Remarks submitted with said Amendment are included below under "Response to Arguments".

Information Disclosure Statement

With reference to the Interview Summary enclosed with this action, examiner makes of record to have inquired telephonically with applicant's representative (I. J. Schultz, Reg. No.: 28,666) about whether, as the PALM record appears to show, an Information Disclosure Statement was filed in the application during 2006. Applicant's Representative stated that no Information Disclosure Statement has to date been filed during 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claim 7*** is rejected under 35 U.S.C. 102(e) as being anticipated by Nitta et al (US 2002/0190262 A1).

Nitta et al teach an LED device (Figures 25 and 29 (N.B.: see also Figures 2 and 4 for description of the properties of the first embodiment over which Figures 25 and 29 distinguish through the addition of phosphor particles 110; see below); title, abstract, [0040]-[0154], and [0332]-[0340]) comprising: an LED mounted on a substrate (any of resin stem 100 (see [0083]-[0087], lead 101 ([0086]), adhesive 107 ([0123]) or the horizontal portion of resin 103 underneath 101; see Figure 1B for numeral 103 to the substrate and see [0090]); a transparent resin 111 ([0085] and [0092]-[0105]) sealing the LED (inherently, silicone resin is transparent and it also must be for the LED to be operative, because 111 embeds the LED; see Figures 25 and 29), the transparent resin including phosphor particles 110 ([0039], [0067], [0069], [0073]) distributed therein inherently capable of changing a chromaticity of light emitted from the LED to another chromaticity, based on the chromaticity of the light emitted from the LED; and

an exposed (see illustration of the first embodiment and of Figures 25 and 29) peripheral portion 213 (see [0136]-[0139] and [0332]-[0333]), of the transparent sealing resin including a permeated dye ([0139] and [0332]-[0333]); said dye is permeated because said dye is colored and for coloring it is necessary that the coloring agent permeates the substance that is colored). Said exposed peripheral portion seals the LED (see Figures 25 and 29).

The further limitation “wherein the permeated dye is specifically selected to correct the color of the light transmitted through the transparent resin including phosphor particles” does not further limit the claimed invention, but instead constitutes a product- by-process limitation. How the permeated dye is selected does not matter for the final structure, given the final structure. A device limitation followed by a method step is only of patentable weight in as much as the method steps distinguish the final structure, and therefore are, to the extent not impacting final structure, taken to be product-by-process limitations and non-limiting. A product by process claim is directed to the product per se, no matter how they are actually made. See *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974); *In re Marosi et al*, 218 USPQ 289, 292 (Fed. Cir. 1983), and *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make clear that it is the patentability of the final structure of the product “gleaned” from the process steps that must be determined in a “product-by-process” claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in “product by process” claims or not.

Finally, with regard to the claim language “for changing” (lines 4-5) and “based upon” (line 6), intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

On claims 3 and 10: Because said dye absorbs light transmitted through the transparent resin and the color inherently represents the light NOT absorbed said dye has a complementary color to the color of the light transmitted through the transparent resin, and hence the further limitation defined by claim 3 is met.

In reference to the claim language referring to “for a desired color of light”, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

On claim 8: the LED device is capable for producing white light (see [0230]).

Response to Arguments

Applicant's arguments with respect to claims 3, 7, 8 and 10 have been considered but are moot in view of the new ground(s) of rejection over Nitta et al (US 2002/0190262 A1) necessitated by the substantial amendment, which overcame the previous rejection(s) only because the peripheral portion as claimed (previously

outer surface) is exposed. In response to specific comments in Remarks, applicant is reminded again that how "chromaticity is corrected after the manufacture" and that the "invention provides means for correction after manufacture" (see page 2): both are irrelevant for the device invention of applicant, but instead constitute at best patentable limitations in an application on the method of making said device. A product by process claim is directed to the product per se, no matter how they are actually made. See *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974); *In re Marosi et al*, 218 USPQ 289, 292 (Fed. Cir. 1983), and *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make clear that it is the patentability of the final structure of the product "gleaned" from the process steps that must be determined in a "product-by-process" claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM
March 31, 2006

Patent Examiner:


Johannes Mondt (Art Unit: 3663)